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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/883,258	06/19/2001	Takashi Nishioka	209989US0	9566

22850 7590 05/22/2003

OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C.  
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EXAMINER

THORNTON, YVETTE C

ART UNIT

PAPER NUMBER

1752

DATE MAILED: 05/22/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Ch

<b>Office Action Summary</b>	<b>Application No.</b> 09/883,258	<b>Applicant(s)</b> NISHIOKA ET AL.	
	<b>Examiner</b> Yvette C. Thornton	<b>Art Unit</b> 1752	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 26 March 2003.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) 3-13 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2 and 14-27 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                             | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____                                    |

### DETAILED ACTION

This is written in reference to application number 09/883258 filed on June 19, 2001 and published as US 2002/0018958 A1 on February 14, 2002.

#### *Response to Amendment*

1. Claims 1-27 are currently pending. Claims 3-13 are directed to a non-elected invention and are withdrawn from further consideration. Claims 16-27 are newly added.
2. The amendment to the abstract is sufficient to overcome the specification objection set forth in the previous office action.

#### *Election/Restrictions*

3. This application contains claims 3-13 drawn to an invention nonelected with traverse in Paper No. 6. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

#### *Notice*

4. Claims 1-2 and 14-27 contain intended use language. Intended use recitations and other types of functional language cannot be entirely disregarded. However, in apparatus, article, and composition claims, intended use must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. In re Casey, 370 F.2d 576, 152 USPQ 235 (CCPA 1967); In re Otto, 312 F.2d 937, 938, 136 USPQ 458, 459 (CCPA 1963).(MPEP 2111.02)

5. Claims 14-15, 19 and 23-27 are product-by-process claims. The product of claims 14 and 15, which is a seal, is obtained by engraving with laser processing a polymer composition. The product of claims 19 and 23, which is a composition, is obtained by kneading a polymer and heating the formed composition. More specifically, the said claims recite method limitations that do not further define the material. Therefore, any method may be used to make the material. Consequently, the burden shifts to Applicant to provide evidence of an unobvious difference between the claimed product and the prior art. Furthermore, "The Patent Office bears a lesser burden of proof in making out a case of prima facie obviousness for product-by-process claims because of their peculiar nature" than when a product is claimed in the conventional fashion. In re Fessmann, 180 USPQ 324,326 (CCPA 1974), see MPEP 2113.

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

7. The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of

the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

8. Claims 1-2, 14-15, 17 and 21 are rejected under 35 U.S.C. 102(e) as being anticipated by Chaudhary et al. (US 6325956 B2). Chaudhary exemplifies comparative samples A-C wherein an ethylene/octene copolymer was admixed with dicumyl peroxide. The sample was mixed for 5 minutes, removed and placed in a press where the peroxide reacted to crosslink the polymer. It is the examiner's position that the taught copolymer would have at least 50% ethylene (c. 28, l. 65-c. 29, l. 25). Comparative sample F exemplifies an ethylene/octene copolymer admixed with azodicarboamide blowing agent, zinc oxide blowing agent and dicumyl peroxide (c. 31, l. 47-c. 32, l. 3). It is the examiner's position that the taught blowing agents meet the limitations of the claimed foaming agents. Chaudhary further teaches a procedure for making foam for comparative sample F (c. 32, l. 60-c. 33, l. 35).

#### *Claim Rejections - 35 USC § 103*

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 16, 18-20 and 22-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chaudhary et al. (US 6325956 B2) as applied to claims 1-2, 14-15, 17 and 21 above. Chaudhary exemplifies all the limitations of the instant claims as discussed

above, except it fails to exemplify a composition further comprising a crosslinkable monomer, a reinforcing agent, or a plasticizer. Chaudhary does however teach that coagents, such as triallyl cyanurate and trimethylpropane trimethacrylate are optionally used to improve the crosslinking efficiency (c. 20, l. 39-41). Carbon black is typically added to improve the tensile strength or toughness of the product or to mask the color of the product (c. 20, l. 45-58). Preferably one or more extender oils will be added to the polymer prior to crosslinking. Extender oils are advantageously added to improve processability and low temperature flexibility as well as to decrease cost. Suitable oils include aromatic, naphthenic and paraffinic extender oils (c. 20, l. 59-c. 21, l. 5). Such additives are provided either prior to, during or subsequent to crosslinking the elastomer. It is the examiner's position that the said coagents meets the limitation of a crosslinkable monomer; carbon black meets the limitation of a reinforcing agent and the extender oils meet the limitation of a plasticizer. It is also the examiner's position that the comparative examples of Chaudhary teach what is conventional and well-known in the art. It would have been obvious to one of ordinary skill in the art to incorporate known additives such as coagents, carbon black and extender oils into the comparative examples of Chaudhary in order to improve the crosslinking efficiency, tensile strength, and processability of a known composition with the expectation that the formed composition would not have the added improvement of better organoleptic qualities as obtained by the invention of Chaudhary (see Chaudhary c. 2, l. 25-28).

#### *Response to Arguments*

11. Applicant's arguments filed March 26, 2003 have been fully considered but they are not persuasive. Applicants argue that the choice of dicumyl peroxide has been eliminated

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from the instant claims. The applicant is in error. The said choice is present in line 7 of instant claim 1-2 and 14 and line 8 of claim 15. Therefore the taught invention clearly anticipates the claimed invention.

12. Applicants further argue that the said reference teaches away from the claimed invention. The examiner is of the position that the comparative examples teach what is conventional in the art. Chaudhary merely teaches an improvement to what is well known in the art.

13. The examiner maintains the rejection of record as discussed above.

#### *Conclusion*

14. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

15. A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.




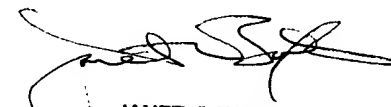
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16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yvette C. Thornton whose telephone number is 703-305-0589. The examiner can normally be reached on Monday-Thursday 8-6:30.

17. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janet C. Baxter can be reached on 703-308-2303. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

18. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1495.

  
yct  
May 20, 2003

  
JANET BAXTER  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1700